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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/717,841 | 11/21/2000 | Arvin D. Danielson | 36767YBB | 6790 |

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| EXAMINER |
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KIM, AHSHIK

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| ART UNIT | PAPER NUMBER |
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2876

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,841

Applicant(s)

DANIELSON ET AL.

Examiner

Ahshik Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/28/04 (Remarks).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-29 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-29 and 37-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Amendment***

1. Receipt is acknowledged of the response filed on October 28, 2004. In the amendment
5 claims 16 was amended. Currently, claims 16-29 and 37-44 remain for examination.

Obviousness-Type Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in
public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise
10 extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple
assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759
F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).

15 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome
an actual or provisional rejection based on a nonstatutory double patenting ground provided the
conflicting application or patent is shown to be commonly owned with this application. See 37
CFR 1.130(b).

20 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer.
A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 16-29 and 37-44 are rejected under the judicially created doctrine of obviousness-
type double patenting as being unpatentable over claims 1-72 of US Patent 6,149,062 to
Danielson et al. (hereinafter '062 patent).

25 Although the conflicting claims are not identical, it is the Examiner's view that they are
not patentably distinct from each other. In claim 16 of the instant application, the Applicant
claims "A data processing system, comprising: (a) a data processing assembly including an
interface unit; and (b) a detachable reader unit detachably assembled with said interface unit; (c)
said detachable reader unit comprising a non-contact data reader to read data disposed in non-
30 contact relationship to said reader unit; wherein said data processing assembly is portable and

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wherein said detachable reader unit dose not extend said data processing assembly's width or length when attached thereto." Claim 1 of '062 patent recites "A hand-held data collection system, comprising: (a) a base unit, of size to be held in one hand during data collection, said base unit comprising a user interface; and b) a detachable reader unit, capable of being coupled

5 with said base unit, said reader unit comprising a non-contact data reader reading data disposed in non-contacting relationship to said reader unit, said reader unit further comprising an energy source." In claim 72 of '062 patent, it is recited "A hand-held data collection system, a

detachable reader unit, capable of being coupled with said base unit, said base unit being contained within said detachable reader unit's confines when coupled therewith, said reader unit

10 comprising a non-contact data reader reading data disposed in non-contacting relationship to said reader unit, said reader unit further comprising an energy source." It appears that when they are coupled, they do not extend each other's dimension.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground
15 provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
20 basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5 5. Claims 16-29 and 37-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Gombrich (US 4,916,441, hereinafter "Gombrich").

Re claims 16, 20, 21, 23, 27, 28, and 37-40, Gombrich discloses a portable hand-held data processing assembly (see figure 6; col. 1, lines 47+) comprising a barcode reader 22 and a base unit 31 (col. 4, lines 38+; col. 5, lines 51+). When the reader is inserted into a base unit,
10 they appear to be one unit – one does not extend the other's dimension (see figure 6).

Re claims 17-19, 24-26, 43, and 44, the reader 22 can read a barcode, and further equipped with keyboard so that users can manually enter data (col. 2, lines 3+)

Re claims 22, 29, and 41 , as shown in figure 5, the terminal can communicate with external devices (or host) via wireless communication (col. 5, lines 34+).

15 Re claim 42, as shown in figure 16, the battery 80 provides operating power to the data collection module (col. 8, lines 62+).

Response to Arguments

6. Applicant's remarks filed on October 28, 2004 have been carefully reviewed and
20 considered.

In remarks, Applicant stated "Further, the prior patent (6,149,062) can not be used as prior art." (See Remarks, page 4, second paragraph) However, Applicant failed to provide a basis for the assertion. It is the Examiner's opinion that Obviousness-Type Double Patenting policy is specifically designed to close the loopholes for unjust and improper extension of the
25 patent term.

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Moreover, if the subject matter amended by wherein clause “wherein said data processing assembly is portable and wherein said detachable reader unit does not extend.....” had been crucially important for the Applicant, there’s no explanation why such feature was not initially claimed. In fact, claim 1 of 5,227,614 patent (claim 1, part (c)) even recites the size parameters – “said computer processing module means having a cross section with a perimeter of not more than ten inches and having a length dimension extending transverse to such cross section of not more than seven inches

It is the Examiner’s view that subject matter disclosed in the application should be claimed within a reasonable time period, particularly the subject matter to be claimed later could be considered a relatively common concept (or could be contemplated by one ordinary skill in the art). It is hard to fathom that Applicant who has a patentable idea waits almost 20 years to file an application to claim his/her invention, and still claims the benefit of earlier filing date by filing a series of convoluted continuation-in-part and continuation applications.

Additional Remarks

7. Examiner is aware that Applicant argues that the claimed subject matter are disclosed in US 5,227,614, filed on December 15, 1989. It is also noted that US 5,227,614 claims continuation-in-part (CIP) benefit of Ser. No. 143,921, which claims CIP benefit of 897,547, filed Aug 15, 1986.

In order for an application to be filed as CIP, MPEP states “adding matter not disclosed in the said nonprovisional application . (In re Klein, 1930 C.D. 2, 393 O.G. 519 (Comm’r Pat. 1930)).” (See MPEP 201.08.). Examiner is unable to track Ser No. 143,921 and Ser No.

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897,547. Examiner respectfully requests the Applicant to submit the paperworks for these applications (if the records exist). Otherwise, Applicant should submit a statement that the claimed subject matter was not disclosed in either Ser. No. 143,921, and Ser. No. 897,547. Until the subject matter for these applications are reviewed or Applicant's submission of the statement,

5 Examiner can only acknowledge the filing date of US 5,227,614, which is December 15,1989.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: XXXXX disclose two dimensional data reading and related methods. Applicant is respectfully suggested to carefully review these references.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

15 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

20 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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Ahshik Kim
Patent Examiner
Art Unit 2876
January 10, 2005

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